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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,300	03/21/2001	Binnur Al-Kazily	10004461-1	4819

7590 09/13/2004

HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
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EXAMINER

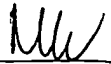
VIG, NARESH

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/814,300	<b>Applicant(s)</b> AL-KAZILY ET AL.	
	<b>Examiner</b> Naresh Vig	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

This is in reference to response received on 26 May 2004 to the office action mailed on 30 March 2004. There are 20 claims, claims 1 – 20 pending for examination

### ***Response to Arguments***

Applicant's arguments with respect to claims 1 - 20 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument that reliability of PhotoAccess disclosure is in question. In the cited reference on pages 6, 7, 10, 12, 13, 15 and 17 recite PhotoAccess was founded in 1998. New items starting page 5 of the cited references are all dated later than the news items on page 1 and 3. For this reason, examiner reads PhotoAccess was founded in 1998. Release date of the news items in the cited references are prior to the claimed priority date of the applicant's invention.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 – 7, 10, 11 – 14 and 18 – 19 are rejected under 35 U.S.C. 102(e) as being unpatentable over Anderson US Publication 2002/0087622.

Regarding claim 1, Anderson teaches an on-line system for providing imaging services. Anderson teaches:

client-ware running on a web-enabled imaging device for submitting requests for imaging services available on an on-line imaging services site ( ) [0005]; the camera is provided with a software application that is pre-configured to establish communication with the ISP and the gateway server

said device including a user profile containing information associated with said imaging services (Upon establishing a connection, the camera sends the user's account ID and password to the gateway server) [0005].

Regarding claim 2, Anderson teaches information contained in the user profile includes identifying information (Upon establishing a connection, the camera sends the user's account ID and password to the gateway server) [0005].

Regarding claim 3, Applicant recites "These preferences may include the specific or alternative services sites to which a user subscribes, the on-line location in which a user wishes to publish or store his or her images, a list of addressees to whom a user wishes to forward certain images, the manner of publication and display of images on the services site or other preferred site, the format or number of prints for submitted images, user information such as name, last name, address, payment information, device related information, and other particulars.". Anderson teaches information contained in the user profile further includes preferences for the available services (Services available to a camera may include the ability to send images from the camera to a specific photo-service service and the ability to send emails with links to uploaded images) [0006].

Regarding claim 4, Anderson teaches services on-line imaging site includes server-ware for servicing the requests submitted by the client-ware for imaging services [0007].

Regarding claim 5, Anderson teaches server-ware services a request submitted by the client-ware based on information included in the user profile [0006, 0007].

Regarding claim 6, Anderson teaches client-ware transfers one or more images to the server-ware (an inventory of images stored on the device is received from the device) [abstract].

Regarding claim 7, Anderson teaches client-ware submits a request for said one or more images to be published on-line in accordance with information contained in the user profile (Services available to a camera may include the ability to send images from the camera to a specific photo-service service) [0006].

Regarding claim 10, Anderson teaches user profile is partly stored on the on-line imaging services site (it is inherent that Anderson uses data on its server to authenticating the client device).

Regarding claim 11. Anderson teaches a user profile stored in a web-ready imaging device, for accessing digital imaging services available on an on-line digital imaging services site (The user account information is then stored on the camera for use the next time the electronic device accesses the website) [0005].

Regarding claim 12, Anderson teaches information identifying the on-line digital imaging services site (the camera is provided with a software application that is pre-configured to establish communication with the ISP and the gateway server) [0005].

Regarding claim 13, Anderson teaches account information for authenticating against the on-line digital imaging services site (authentication services (user and device) [0006].

Regarding claim 14, Anderson teaches account information includes unique identification information for uniquely identifying a user account on the on-line digital imaging services site site (authentication services (user and device) [0006].

Regarding claim 18, Anderson teaches providing on-line imaging services in a system comprising a digital imaging services site and web-enabled imaging device including a user profile. Anderson teaches:

connecting the web-enabled imaging device directly to an Internet service provider [0005];

establishing a connection between the imaging services site designated in the user profile and the device [0005, 0006];

submitting a request generated by the device for imaging services to the digital imaging services site [0005], 0006;

examining the user profile for information pertaining to the submitted request at the imaging services site, in response to said request [0006]; and

providing one or more imaging services in accordance with the submitted request and information included in the user profile [0005 – 0007].

Regarding claim 19, Anderson teaches:

submitting identifying information included in the user profile to the imaging services site to access digital imaging services available on the imaging services site (authentication) [0006];

receiving permission to access the available digital imaging services in response to submitting identifying information (it is inherent that after authenticating the user, Anderson permits user to access the system) [0006];

transferring one or more images stored in the web-enabled imaging device to the imaging services site (an inventory of images stored on the device is received from the device) [0017].



***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 – 9, 15 – 16 and 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson US Publication 2002/0087622 in view of PhotoAccess Corporation hereinafter known as PhotoAccess.

Regarding claim 8, Anderson does not teach client-ware submits a request for said one or more images to be printed in accordance with information contained in the user profile. However, PhotoAccess teaches client-ware submits a request for said one or more images to be printed in accordance with information contained in the user profile [page 7, 9].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Anderson as taught by PhotoAccess to minimize user interaction.

Regarding claim 9, Anderson does not teach client-ware submits a request for said one or more images to be electronically forwarded to one or more recipients in accordance with information contained in the user profile. However, Anderson teaches

the image gateway 18 enables a user with images stored on one photo-host site to access to the services of all print service providers who also use the image gateway 18 [0028]. PhotoAccess teaches client-ware submits a request for said one or more images to be electronically forwarded to one or more recipients in accordance with information contained in the user profile [page 7].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Anderson as taught by PhotoAccess and forward images to one or more recipients to enable the recipients to process the digital images.

Regarding claim 15, Anderson does not teach user preference information regarding the manner of publishing one or more images on the on-line digital imaging services site. However, PhotoAccess teaches user preference information regarding the manner of publishing one or more images on the on-line digital imaging services site [page 7].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Anderson as taught by PhotoAccess to minimize user interaction.

Regarding claim 16, Anderson does not teach user preference information regarding printing one or more images uploaded to the on-line digital imaging services

site. However, Anderson teaches the image gateway 18 enables a user with images stored on one photo-host site to access to the services of all print service providers who also use the image gateway 18 [0028]. PhotoAccess teaches user preference information regarding printing one or more images uploaded to the on-line digital imaging services site [page 7].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Anderson as taught by PhotoAccess and forward images to one or more recipients to enable the recipients to process the digital images.

17 The user profile of claim 11 comprising user preference information regarding electronically forwarding one or more images uploaded to the on-line digital imaging services site to one or more recipients.

Regarding claim 17, Anderson does not teach user preference information regarding electronically forwarding one or more images uploaded to the on-line digital imaging services site to one or more recipients. However, Anderson teaches the image gateway 18 enables a user with images stored on one photo-host site to access to the services of all print service providers who also use the image gateway 18 [0028]. PhotoAccess teaches client-ware submits a request for said one or more images to be electronically forwarded to one or more recipients in accordance with information contained in the user profile [page 7].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Anderson as taught by PhotoAccess and forward images to one or more recipients to enable the recipients to process the digital images.

Regarding claim 20. Anderson does not teaches submitted request by the web-enabled imaging device is to store said one or more transferred images in an on-line location in accordance with information included in the user profile. However, Anderson teaches indication of whether each image is stored on the device or on the photo-service site [0017]. PhotoAccess teaches request submitted by the web-enabled imaging device is to store said one or more transferred images in an on-line location in accordance with information included in the user profile [page 7].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Anderson as taught by PhotoAccess to minimize user interaction.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

1. Morris US Patent 6,453,361

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is 703.305.3372. The examiner can normally be reached on M-F 7:30 - 5:00 (Alt Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703.308.2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naresh Vig  
Patent Examiner  
September 7, 2004